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224



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,948	04/30/2001	Tatsuo Itabashi	112857-222	3323

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EXAMINER

KIM, JUNG W

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/845,948	Applicant(s) ITABASHI, TATSUO	
	Examiner Jung W Kim	Art Unit 2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) * | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Claims 1-28 have been examined.

Claim Objections

2. Claim 28 is objected to because of the following informalities: the claim refers to a program claimed in claim 24, however, claim 24 claims an information providing method; a program is claimed in claim 25. Appropriate correction is required.

Specification

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: "Information providing system utilizing IC cards and method thereof".

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 2132

6. Claim 20 recites the limitation "the communication terminal device" in line 9.

There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1, 3-8, 10-12, 14, 15 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Davis et al. U.S. Patent No. 6,282,522 (hereinafter Davis).

9. As per claim 1, Davis discloses an information providing system for enabling the viewing of contents of a data holding device capable of holding data including personal information for recognizing at least users, using a communication terminal device (see Davis, Figure 4, Reference Nos. 5, 204 and 210), the system comprising:

- a. a first information processing unit for monitoring and holding contents information of the data in the data holding device, and providing the contents information held therein upon receiving a contents information readout request (see Davis, Figure 4, Reference Nos. 224 and 226); and
- b. a second information processing unit for receiving contents information access requests sent from the communication terminal device via a communication network and outputting the contents information readout request to the first information processing unit so as to request supply of contents information of the data holding device, and transmitting the supplied contents information to the communication terminal device (see Davis, Figure 4, Reference Nos. 206 and 214-216; Figure 5, Reference Nos. 206 and 214);
- c. wherein the communication terminal device includes a display unit, a communication unit, and a transmitter for transmitting the contents information access requests from the communication unit to the second information processing unit, and receiving the contents information of the data holding device transmitted from the second information processing unit, such that received contents information is displayed on the display unit (see Davis, col. 12, lines 23-45).

The aforementioned cover the limitations of claim 1.

10. As per claim 3, Davis discloses a system as outlined above in the claim 1 rejection under 35 U.S.C. 102(e). In addition, the system further comprises: a dedicated terminal device for performing exchange of data between the first information processing unit and the data holding device, wherein the first information processing unit performs predetermined processing based on the data holding device data, and updates the data held therein. See Davis, col. 12, lines 1-45. The aforementioned cover the limitations of claim 3.

11. As per claim 4, Davis discloses a system as outlined above in the claim 1 rejection under 35 U.S.C. 102(e). In addition, the data holding device is an IC card. See Davis, col. 10, line 66-col. 11, line 47. The aforementioned cover the limitations of claim 4.

12. As per claim 5, Davis discloses a system as outlined above in the claim 1 rejection under 35 U.S.C. 102(e). In addition, the communication terminal device is a cellular telephone, and wherein the cellular telephone and the second information processing unit are connected via a cellular telephone communication network. See Davis, col. 12, lines 7-11. The aforementioned cover the limitations of claim 5.

13. As per claim 6, Davis discloses a system as outlined above in the claim 1 rejection under 35 U.S.C. 102(e). In addition, the communication terminal device is a personal computer communication terminal device, and wherein the personal computer communication terminal device and the second information processing unit are connected via the internet. See Davis, Abstract and col. 12, line 5. The aforementioned cover the limitations of claim 6.

14. As per claims 7 and 8, Davis discloses a method as outlined above in the claim 1 and 3 rejections under 35 U.S.C. 102(e). In addition, the method handles a plurality of data holding devices and data held in the multiple data holding devices are supplied to parties requesting access to the held data. See Davis, col. 6, lines 18-26; Figure 4, Reference Nos. 324, 236 and 235. The aforementioned cover the limitations of claims 7 and 8.

15. As per claim 10, Davis discloses a method as outlined above in the claim 7 rejection under 35 U.S.C. 102(e). In addition, the supplied contents information is displayed on a predetermined terminal device. See Davis, col. 7, lines 11-12. The aforementioned cover the limitations of claim 10.

16. As per claim 11, Davis discloses a system as outlined above in the claim 7 rejection under 35 U.S.C. 102(e). In addition, the method further comprises the steps of:

- d. performing settlement processing regarding settlement performed by the data holding device (see Davis, Figure 5, Reference Nos. 308, 314 and 318); and
- e. updating the contents information of data of the data holding device generated by the settlement processing, and transmitting to the data holding device (see Davis, Figure 5, Reference No. 318).

The aforementioned cover the limitations of claim 11.

17. As per claim 12, Davis discloses a method as outlined above in the claim 11 rejection under 35 U.S.C. 102(e). In addition, the updated information is displayed on the communication terminal device. See Davis, Figure 10, Reference Nos. 514 and 516. The aforementioned cover the limitations of claim 12.

18. As per claim 14, Davis discloses an information providing system for performing predetermined processing using a data holding device capable of holding data including personal information for recognizing at least users, and a communication terminal device, the system comprising:

- a. a first information processing unit which, upon receiving transaction start information via a communication network, outputs a verification response confirmation request, performs predetermined processing based on the data of the data holding device upon receiving a response signal sent from the communication terminal device, and holds at least processing data (see Davis, Figure 4, Reference Nos. 224 and 226 and related text); and

b. a second information processing unit which, upon receiving the verification response request, confirms the communication terminal device corresponding to the identification information of the data holding device registered beforehand, calls up the communication terminal device via the communication network, and upon receiving a response signal from the communication terminal device supplies the response signal to the first information processing unit (see Davis, Figure 5, Reference No. 206 and 214, and related text).

The aforementioned cover the limitations of claim 14.

19. As per claim 15, Davis discloses a system as outlined above in the claim 14 rejection under 35 U.S.C. 102(e). In addition, the first information processing unit receives identification information of the data holding device in addition to transaction start information, performs collation of the identification information, and in the event that positive results are obtained from the collation, outputs a certification response confirmation request to the second information processing unit. See Davis, Figure 7, Reference No. 356. The aforementioned cover the limitations of claim 15.

20. As per claim 18, Davis discloses a system as outlined above in the claim 14 rejection under 35 U.S.C. 102(e). In addition, the first information processing unit monitors and holds contents information of data of the data holding device, and upon receiving a contents information readout request provides the contents information held

Art Unit: 2132

in the corresponding data holding device to the requesting party (see Davis, Figure 7, Reference No. 234);

- a. and wherein, upon receiving a contents information access request, the second information processing unit outputs a contents information readout request to the first information processing unit and requests the contents information of the data holding device, and transmits supplied contents information to the communication network (see Davis, Figure 7, Reference Nos. 310, 312, 314a and 316a);
- b. and wherein the communication terminal device further includes at least a display unit, with the contents information access request being transmitted by the communication unit thereof to the second information processing unit via the communication network, the contents information being displayed on the display unit upon the contents information of the data holding device transmitted from the first information processing unit having being received via the communication network (see Davis, Figure 7 and Figure 10, Reference Nos. 512, 514 and 516).

The aforementioned cover the limitations of claim 18.

21. Claims 25 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Claus U.S. Patent No. 5,461,217 (hereinafter Claus).

22. As per claim 25, Claus discloses a program for a computer, wherein the computer executes the steps of:

- a. receiving data of a shop data holding device capable of holding data containing information identifying at least providers which provide products or services, transmitted from a communication terminal device (see Claus, Figure 1, Reference Nos. 105, 130, 143 and 151);
- b. receiving data of the shop data holding device and performing predetermined collation thereof, and upon obtaining positive collation results transmitting a transaction processing continuation signal to the communication terminal device (see Claus, Figure 1, Reference Nos. 110, 116, 141 and 145);
- c. receiving data of a user data holding device capable of holding data containing personal information identifying at least users, transmitted from the communication terminal device (see Claus, Figure, 1, Reference Nos. 107, 114 and 149); and
- d. upon receiving the data of the user data holding device, performing predetermined processing based on the data, and holding at least processing data (see Claus, Figure 1, Reference Nos. 122 and 126; Figure 2).

The aforementioned cover the limitations of claim 25.

23. As per claim 26, Claus discloses a program for a computer as outlined above in the claim 25 rejection under 35 U.S.C. 102(b). In addition, in the data reception step, identification information of the user data holding device is received in addition to the data of the user data holding device; and wherein, in the processing data holding, upon performing collation of the identification information and obtaining positive collation

results, predetermined processing is performed based on the data of the user data holding device. See Claus, Figure 1, Reference Nos. 114, 122 and 126; Figure 2. The aforementioned cover the limitations of claim 26.

Claim Rejections - 35 USC § 103

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. Claims 2, 9, 13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis in view of Walker et al. U.S. Patent No. 5,828,751 (hereinafter Walker).

26. As per claim 2, Davis discloses a system as outlined above in the claim 1 rejection under 35 U.S.C. 102(e). In addition, the communication terminal device transmits IC card identification information in addition to the contents information access request, and wherein the second information processing unit collates received IC card identification information and pre-registered identification information, and outputs the contents information readout request to the first information processing unit in the event that the received identification information and pre-registered identification information match. See Davis, col. 17, lines 27-51. However, Davis does not teach transmitting and verifying terminal identification information. Walker teaches transmitting and

verifying terminal identification information to ensure the identity of the device handling a transaction. See Walker, col. 4, line 38. It would be obvious to one of ordinary skill in the art at the time the invention was made to transmit and verify the terminal identification information in the system of Davis to secure the terminal device as taught by Walker. Ibid. The aforementioned cover the limitations of claim 2.

27. As per claim 9, it is a method claim corresponding to claims 2 and 8, and it does not teach or define above the information claimed in claims 2 and 8. Therefore, claim 9 is rejected as being unpatentable over Davis in view of Walker for the same reasons set forth in the rejections of claims 2 and 8.

28. As per claim 13, it is a method claim corresponding to claim 2, and it does not teach or define above the information claimed in claim 2. Therefore, claim 13 is rejected as being unpatentable over Davis in view of Walker for the same reasons set forth in the rejection of claim 2.

29. As per claim 16, it is a claim covered by the teachings outlined in the claim 2 and 14 rejections, and it does not teach or define above the inventions outlined in the claim 2 and 14 rejections. Therefore, claim 13 is rejected as being unpatentable over Davis in view of Walker for the same reasons set forth in the rejections of claims 2 and 14.

30. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Davis in view of Nerlikar U.S. Patent No. 5,629,981 (hereinafter Nerliker).

31. As per claim 17, Davis covers a system as outlined above in the claim 14 rejection under 35 U.S.C. 103(a). Davis does not disclose controlling output response signals based on position information of the communication terminal device. Nerliker teaches verifying a message from a device based on, inter alia, position information of the device, wherein the received position data from the device is compared to the expected position data, and if a match is found then the message is verified. See Nerliker, Figure 6; col. 9, lines 40-50. It would be obvious to one of ordinary skill in the art at the time the invention was made to continue transaction processing when the location of a device is verified to ensure that a requesting party of a transaction is verified to perform transactions within authorized areas. See Nerliker, col. 2, lines 39-50. The aforementioned cover the limitations of claim 17.

32. Claims 19-21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis in view of Claus.

33. As per claims 19 and 20, Davis covers a system as outlined above. Davis does not disclose a second data holding device capable of holding data containing information that identify providers which provide at least products or services. Claus teaches transfer techniques using smart cards where a first data holding device is

capable of holding personal information identifying at least users, and a second data holding device is capable of holding data containing information identifying providers which provide at least products or services. See Claus, col. 2, lines 44-57. It would be obvious to one of ordinary skill in the art at the time the invention was made for data holding devices to be utilized by both at least users and at least providers to ensure the security and identity of both parties of a transaction as taught by Claus. Ibid. Hence, the invention covered by Davis in view of Claus covers the following:

- a. a first data holding device capable of holding data containing personal information identifying at least users (see Claus, Figure 1, Reference Nos. 102 and 107);
- b. a second data holding device capable of holding data containing information identifying providers which provide at least products or services (see Claus, Figure 1, Reference Nos. 104 and 105);
- c. a communication terminal device capable of performing data exchange between the first and second data holding devices and capable of communicating via a communication network (see Claus, Figure 1, Reference No. 106); and
- d. an information processing unit which performs predetermined collation upon reception of data of the second data holding device transmitted from the communication terminal device, and upon obtaining positive collation results transmits a transaction processing continuation signal to the communication terminal device via the communication network, and then upon receiving the data

of the first data holding device performs predetermined processing based on the received data, and holds at least processing data (see Davis, Figure 4, Reference Nos. 206, 214-216 and 238; Figure 5, Reference Nos. 312, 314, 324 and 326; col. 14, lines 18-25).

The aforementioned cover the limitations of claims 19 and 20.

34. As per claim 21, Davis covers a method as outlined above in the claim 19 and 20 rejections under 35 U.S.C. 103(e). In addition, in the data transmitting step of the first data holding device, identification information of the first data holding device is transmitted in addition to the data, and in the processing data holding step, collation of the identification information is performed, and in the event that positive collation results are obtained, predetermined processing is performed based on the data of the first data holding device. See Davis, Figure 5, References No. 324 and 326. The aforementioned cover the limitations of claim 21.

35. As per claim 24, Davis covers a method as outlined above in the claim 21 rejection under 35 U.S.C. 103(a). In addition, the first and second data holding devices are each IC cards. See Claus, Figure 5, Reference Nos. 102 and 104. The aforementioned cover the limitations of claim 24.

36. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis in view of Claus, and further in view of Nerlikar.

37. As per claim 22 and 23, Davis covers a system as outlined above in the claim 20 and 21 rejections under 35 U.S.C. 103(a). Davis does not disclose controlling output response signals based on position information of the communication terminal device. Nerliker teaches verifying a message from a device based on, inter alia, position information of the device, wherein the received position data from the device is compared to the expected position data, and if a match is found then the message is verified. See Nerliker, Figure 6; col. 9, lines 40-50. It would be obvious to one of ordinary skill in the art at the time the invention was made to continue transaction processing when the location of a device is verified to ensure a requesting party of a transaction is verified to perform transactions within authorized areas. See Nerliker, col. 2, lines 39-50. The aforementioned cover the limitations of claims 22 and 23.

38. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Claus in view of Nerlikar.

39. As per claim 27, Claus discloses a program as outlined above in the claim 25 rejection under 35 U.S.C. 102(b). Claus does not disclose controlling output response signals based on position information of the communication terminal device. Nerliker teaches verifying a message from a device based on, inter alia, position information of the device, wherein the received position data from the device is compared to the expected position data, and if a match is found then the message is verified. See

Art Unit: 2132

Nerliker, Figure 6; col. 9, lines 40-50. It would be obvious to one of ordinary skill in the art at the time the invention was made to continue transaction processing when the location of a device is verified to ensure a requesting party of a transaction is verified to perform transactions within authorized areas. See Nerliker, col. 2, lines 39-50. The aforementioned cover the limitations of claim 27.

40. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Claus in view of Davis.

41. As per claim 28, Claus discloses a program as outlined above in the claim 25 rejection under 35 U.S.C. 102(b). Claus does not disclose the communication terminal device is a cellular phone. Davis teaches a payment system using a smart card wherein the communication terminal device communicating with the smart card in a payment transaction is a cellular phone. See Davis, col. 12, lines 7-11. It would be obvious to one of ordinary skill in the art at the time the invention was made for the communication terminal device to be a cellular phone. Motivation for combination enables users to make secure transactions using the convenience and portability of a mobile phone as known to one of ordinary skill in the art and as taught by Davis. Ibid. The aforementioned cover the limitations of claim 28.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Oneda U.S. Patent No. 5,965,860.

Tomoyuki et al. U.S. Patent No. 5,991,747.

Shiobara et al. U.S. Patent No. 6,105,864.

Kawamoto U.S. Patent No. 6,108,554.

Telephone Inquiry Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jung W Kim whose telephone number is (703) 305-8289. The examiner can normally be reached on M-F 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703) 305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2132

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Jung W Kim
Examiner
Art Unit 2132

Jk
September 23, 2004



GILBERTO BARRON
SUPERVISORY PATENT EXAMINER
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